



03-16-05

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3764

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of
Callister et al.

) Examiner: Michael A. Brown

) Group Art Unit: 3764

For: **OCCLUDING DEVICE AND METHOD
OF USE**

Serial No.: 09/911,551

) **TRANSMITTAL**

Filed: July 23, 2001

Atty. Docket No.: R0371-00402

Express Mail Label No.: ED 037316856 US
Mailed in San Francisco, CA on March 14, 2005

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. Transmitted herewith for filing in the above-identified patent application are the following:

- X Communication; and
- X Form PTO-1449 and copies of 24 cited references; and
- X Self-stamped return receipt postcard.

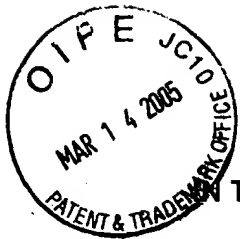
2. Payment of Fees

- X Applicants believe that there is no fee due with this communication. However, should the Commissioner find otherwise, the Commissioner is authorized to charge any fees and to credit any overpayment of fees which may be required under 37 C.F.R. §1.16 or §1.17, to Deposit Account No 04-1679, referencing Atty. Docket No. R0371-00402. **A duplicate copy of this transmittal is enclosed for this purpose.**

Respectfully submitted,

By: 
Edward J. Lynch
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Attorney for Applicants

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PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of
Callister et al.

) Examiner: Michael A. Brown

) Group Art Unit: 3764

For: **OCCLUDING DEVICE AND METHOD
OF USE**

Serial No.: 09/911,551

) **COMMUNICATION**

Filed: July 23, 2001

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Commissioner for Patents
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Alexandria, VA 22313-1450

Dear Sir:

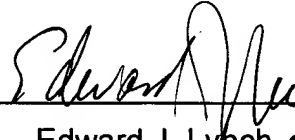
In compliance with 37 C.F.R. §1.98(a)(1) and as recommended by the communication mailed February 22, 2005 from the U.S. Patent and Trademark Office, Applicants hereby submit the enclosed form PTO 1449 listing litigation related documents referenced in the Information Disclosure Statement filed September 14, 2004. Applicants have formally listed the prior art formally on the attached form PTO-1449 and have enclosed herewith a copy of the references listed in the attached, except as follows C28-C34. The prior art listed as numbers C28-C34 in the attached are under protective order in Civil Action Nos. C 02-1968 MFP and C 02-3884 MHP in the United States District Court for the Northern District of California and we are unable to provide copies of these documents until the protective order is waived as to these documents. Applicants herein have asked the plaintiff in the two aforementioned civil actions for

permission to disclose these papers. When the protective order is waived, Applicants herein will submit these documents to the Patent Office in due course.

Applicants respectfully request consideration of the enclosed listed prior art.

Applicants note with appreciation that claims 1-72 are allowed.

Respectfully submitted,

By: 
Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NO.:

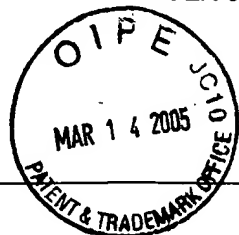
SERIAL NO.:

INFORMATION DISCLOSURE STATEMENT

UNDER 37 CFR §1.56, §1.97, and §1.98

PTO-1449 FORM

SHEET 1 OF 2



R0371-00402

09/911,551

APPLICANTS:

Callister et al.

EXAMINER

Michael A. Brown

FILING DATE:

July 23, 2001

GROUP ART UNIT:

3764

OTHER DOCUMENTS

| † EX'R INITIAL | *REF. # | Document Description (including Author, Title, Date, Pertinent Pages, Etc.) |
|-------------------|---------|--|
| | C4 | Docket for Civil Action No. C 02 1968 MHP (U.S. District Court for the Northern District of California). |
| | C5 | Docket for Civil Action No. C 02 3884 MHP (U.S. District Court for the Northern District of California). |
| | C6 | First Amended complain For (1) Declaratory Judgment of Patent Non-Infringement, Invalidity And Unenforceability; (2) False Advertising Under 15 USC §1125(A); (3) Trade Libel; (4) Unfair Competition Under Common Law And Cal. B&P §17200 Et Seq.; (5) Unjust Enrichment; and (6) Constructive Trust Demand For Jury Trial, June 13, 2002. |
| | C7 | Conceptus' Amended Answer To Ovion's Complaint, Affirmative Defenses And Counterclaims, September 26, 2002. |
| | C8 | Ovion's Reply To Amended Counterclaims Of Conceptus, October 25, 2002 |
| | C9 | First Amended Complaint For Willful Patent Infringement, Fraud And Misrepresentation, Misappropriation, Unjust Enrichment, Unfair Business Practices, Trade Libel, Slander Of Title, Monopolization, Attempt To Monopolize And Sham Litigation, August 25, 2003. |
| | C10 | Conceptus' Second Amended Answer, Affirmative Defenses And Counterclaims For: (1) Declaratory Judgment Of Non-Infringement; (2) Declaratory Judgment Of Unenforceability; (3) Declaratory Judgment Of Invalidity; (4) Correction Of Inventorship of '052 Patent Under 35 USC §256; (5) Correction of Inventorship Of '116 Patent Under 35 USC §256; (6) Fraud And Deceit; (7) Trade Libel; (8) Slander Per Se; (9) Libel; (10) Unfair Competition; And, (11) Slander Of Title, July 2, 2003. |
| | C11 | Joint Claim Construction And Prehearing Statement Pursuant To Patent Local Rule 4-3, August 6, 2003. |
| | C12 | Stipulation And Order Of Dismissal, November 13, 2003. |
| | C13 | Ovion's Response To Conceptus' Interrogatories Nos. 2-4, 6-10, and 12-13, November 1, 2002. |
| | C14 | Ovion's Corrected Disclosure of Asserted Claims and Preliminary Infringement Contentions, November 19, 2002. |
| | C15 | Ovion's Corrected Supplemental Statement Regarding Dates of Invention, November 19, 2002. |
| | C16 | Ovion's Second Supplemental Statement Regarding Dates of Invention, December 20, 2002. |
| | C17 | Letter from L. Hansen to Judge Patel, July 28, 2003. |
| | C18 | Letter from L. Hansen to Judge Patel, August 5, 2003. |
| | C19 | Letter from L. Hansen to Judge Patel, August 7, 2003. |
| | C20 | Letter from J. Benassi to Judge with declarations of E. Brann and A. Khera, August 8, 2003. |
| | C21 | Letter from E. Brann to Judge Patel with signed declaration of A. Khera, August 13, 2003. |
| | C22 | Letter from L. Hansen to Judge Patel, August 15, 2003. |
| | C23 | Letter from L. Hansen to Judge Patel, enclosing for submission on behalf of Ovion its First Amended Complaint, August 25, 2003. |

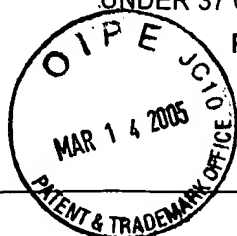
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INFORMATION DISCLOSURE STATEMENT

UNDER 37 CFR §1.56, §1.97, and §1.98

PTO-1449 FORM

SHEET 2 OF 2



ATTORNEY DOCKET NO.:

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APPLICANTS:

Callister et al.

EXAMINER

Michael A. Brown

FILING DATE:

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OTHER DOCUMENTS CONT'D

| † EX'R INITIAL | *REF. # | Document Description (including Author, Title, Date, Pertinent Pages, Etc.) |
|-------------------|---------|--|
| | C24 | Letter from J. Benassi to Judge Patel, August 28, 2003. |
| | C25 | Conceptus' Motion for Summary Judgment of Invalidity of the Asserted '116 patent Claims in View of Conceptus, Inc.'s '979 Patent, October 6, 2003. |
| | C26 | Ovion's Motion To Change Time for Conceptus' Inappropriate Summary Judgment Motions, October 10, 2003. |
| | C27 | Declaration of Leland G. Hansen In Support Of Ovion's Motion To Change Time, with Exhibits 1-8, October 10, 2003. |
| | C28** | Plaintiff Conceptus, Inc.'s Response to Defendant Ovion, Inc.' First Set of Interrogatories Nos. 1-6, November 1, 2002 |
| | C29** | Plaintiff Conceptus Inc.'s Initial Disclosure Pursuant to Fed.R.Civ.P. 26(a)(1), November 1, 2002. |
| | C30** | Plaintiff Conceptus, Inc.'s Supplemental Written Statement Concerning Dates of Invention, December 20, 2002. |
| | C31** | Plaintiff Conceptus, Inc.'s Supplemental Response to Defendant Ovion, Inc.'s Interrogatory No. 1, December 20, 2002. |
| | C32** | Plaintiff Conceptus Inc.'s Corrected Supplemental Response to Defendant Ovion, Inc.'s Interrogatory No.1, January 6, 2003. |
| | C33** | Plaintiff Conceptus, Inc.'s Corrected Supplemental Written Statement Concerning Dates of Invention, January 6, 2003. |
| | C34** | Conceptus, Inc.'s Preliminary Invalidity Contentions, April 30, 2003. |
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EXAMINER'S SIGNATURE

DATE CONSIDERED

† EXAMINER: Initial if reference is considered, whether or not citation is in conformance with MPEP 609.
Line through citation if not in conformance and not considered.
Include copy of this form in next communication to applicant.

* If an asterisk is placed beside the reference number, a copy is not provided because the reference was previously cited by or submitted to the PTO in a prior application that is identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120. 37 C.F.R. 1.98(d).

** Litigation related documents, listed but not enclosed herewith due to protective order in Civil Action Nos. C 02-1068 MHP and C 02-3884 MHP.